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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,698	03/18/2004	Michael E. Miller	65937-0047	6051
10/291 7590 05/12/2009 RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610				
EXAMINER FOREMAN, JONATHAN M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,698

Applicant(s)

MILLER ET AL.

Examiner

JONATHAN ML FOREMAN

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2009 and 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 13-16 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-34 is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13, 16, 21-29 and 31 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 30 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9, 16 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,659,956 to Barzell et al.

In regard to claims 9, 16 and 21, Barzell et al. disclose a base (14); a cradle moveably mounted to the base (12); and an indexing guide (24) moveable with the cradle and including a receptacle (33) within which a portion of a medical instrument is received, the indexing guide including at least one guide lock (26) slidably attached to the indexing guide, the guide lock moveable axially through application of an axial force to the guide lock between a locked position, in which the guide lock engages a portion of the medical instrument received within the receptacle to substantially prevent rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle, and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle (Col. 5, lines 1 – 28). Barzell et al. disclose a deployment mechanism (16). The cradle provides for rotational positioning of a tissue receiving opening (Col. 5, lines 20 – 22).

3. Claims 9, 11, 13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0077972 to Tsonton et al.

In regard to claims 9, 11, 13 and 16, Tsonton et al. disclose a base; a cradle moveably mounted to the base (820); and an indexing guide moveable with the cradle and including a receptacle (824) within which a portion of a medical instrument is received, the indexing guide including at least one guide lock (830) slidably attached to the indexing guide, the guide lock moveable axially through application of an axial force to the guide lock between a locked position, in which the guide lock engages a portion of the medical instrument received within the receptacle to substantially prevent rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle, and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle [0117]. Tsonton et al. disclose a deployment mechanism. The medical instrument includes at least one notch (984) and the guide lock is configured to be received in the notch.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

5. Claims 9 and 21 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.

In regard to claims 9 and 21 – 24, Warner et al. disclose a base (12); a cradle (32) movably mounted to the base; and an indexing guide moveable with the cradle and including a receptacle (36) within which a portion of the medical instrument is received, the indexing guide including a guide

lock (38) slidably attached to the indexing guide and selectively engagable with a portion of the medical instrument received within the receptacle to prevent rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein (Col. 4, lines 44 – 46). The guide lock is moveably secured to the indexing guide. Warner et al. disclose a pivotable clamp (48) axially disposed a distance away from the guide lock that is selectively engagable with the medical instrument to inhibit rotation and axial movement (Col. 5, lines 7 – 9). Warner et al. disclose a guide lock that engages a portion of a medical instrument to inhibit rotation and axial movement, but fail to disclose the medical instrument including at least one notch and the guide lock being configured to be received in the notch to prevent movement of the medical instrument, the guide lock being moveable axially through application of an axial force to the guide lock between a locked position, in which the guide lock engages a portion of the medical instrument and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle.

Moctezuma De La Barrera et al. teach a guide lock (122) that engages a portion of a medical instrument to inhibit rotation and axial movement, wherein the medical instrument including at least one notch and the guide lock being configured to be received in the notch, the guide lock being moveable axially through application of an axial force to the guide lock between a locked position, in which the guide lock engages a portion of the medical instrument and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle (Col. 6, lines 40 – 51). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Warner et al. and Moctezuma De La Barrera et al. teach means for locking a medical instrument within a receptacle, it would have been obvious to one skilled in the art

at the time of the invention to substitute one guide lock for the other to achieve the predictable results of holding the medical instrument in a fixed relation to the receptacle.

6. Claims 25 – 29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al. as applied above, and further in view of DE 935,625 to Bodendieck et al.

In regard to claims 25 – 29 and 31, Warner et al. in view of Moctezuma De La Barrera et al. disclose the cradle allowing for rotatably supporting a medical device therein for positioning of the device and the medical instrument being a biopsy device (Col. 5, line 40), but fail to disclose the biopsy device having a handpiece and a cutting element having an outer hub, wherein the cutting element comprises an outer cannula connected to the outer cannula hub and defining a tissue receiving opening and an inner cannula disposed within the outer cannula and attached to the handpiece. Bodendieck et al. teach a biopsy device (Figures 1, 2, 3) having a handpiece and a cutting element having an outer hub, wherein the cutting element comprises an outer cannula (2) connected to the outer cannula hub (Figure 2) and defining a tissue receiving opening (Figure 8) and an inner cannula (3) disposed within the outer cannula and attached to the handpiece (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the biopsy device disclosed by Bodendieck et al. with the microdrive device taught by Warner et al. in view of Moctezuma De La Barrera et al. in order to permit safe and accurate placement of the biopsy device at the desired location (See Abstract).

Allowable Subject Matter

7. Claims 32 – 34 are allowed. Claims 14, 15, 30 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive. Applicant asserts that Moctezuma De La Barrera fail to disclose a guide moveable "between a locked position, in which the guide lock engages a portion of the medical instrument received within the receptacle...and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle". However, the Examiner disagrees. The Examiner considers the guide lock to be in a locked position and engaged with the medical instrument when the spring loaded balls are located within the channel and in an unlocked position, and thus disengaged from the medical instrument received in the receptacle when the spring loaded balls are not within the channel. The claims do not require the guide lock to not touch the medical instrument while in an unlocked position.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736